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EXAMINER

MCAVOY, ELLEN M

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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION. There is no support in the specification for the amendment to claim 1 “and wherein the composition contains no zinc dialkyldithiophosphates”. In the response filed 08 May 2008, applicant argues that support for the amendment is found “at least at page 29, last nine lines, which teach that all X1 to X6 are preferably oxygen, and in Inventive Examples 1 and 3-9 which contain no ZnDTP”. This is not support for the claimed limitation because the specification does not teach that that the lubricating oil compositions contain no zinc dialkyldithiophosphate. The specification teaches on pages 28-29 that the lubricating oil composition of the invention may contain an antiwear agent other than component (A) which includes zinc dialkyldithiophosphates.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1797

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-9 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazato (6,569,818) in combination with Minami et al (5,792,733) or Nishikawa et al (5,245,070).

Applicants' arguments filed 08 May 2008 have been fully considered but they are not persuasive. As previously set forth, Nakazato et al ["Nakazato"] disclose a lubricating oil composition having a low phosphorus (P) content of 0.01 to 0.1 weight %, a sulfur content of 0.01 to 0.3 weight % and a sulfated ash of 0.1 to 1 weight %, which is comprised of (a) a major amount of mineral base oil having a low sulfur (S) content of at most 0.1 weight %, preferably at most 0.005 weight %, (b) an ashless alkenyl or alkyl-succinimide dispersant or derivative thereof in an amount of 0.01 to 0.3 weight % in terms of nitrogen atom content, (c) a metal-containing detergent such as an alkali metal or an alkaline earth metal salt of an alkylsalicylic acid in an amount of about 0.2 to 7 weight %, and may include other metal detergents such as sulfonate detergents, (d) a zinc dialkyl-dithiophosphate in an amount of 0.01 to 0.1 weight % in terms of a phosphorus content, and (e) an oxidation inhibitor selected from the group consisting of a phenol compound and an amine compound in an amount of 0.01 to 5 weight %. See column 2, line 25 to column 3, line 7. Nakazato teaches that the lubricating oil composition may be used in internal combustion engines including gas engines. See column 1, lines 5-11. Nakazato teaches that the lubricating oil compositions may contain other auxiliary additives such as phosphoric acid esters and phosphorous acid esters. Nakazato teaches that the additives can be incorporated into the lubricating oil compositions in an amount ranging from about 0.001 to 3 weight %. See column 7, line 59 to column 8, line 11. Applicants' invention differs by claiming a specific

Art Unit: 1797

phosphorus acid ester compound, that of a triphosphate set forth by formula (1) in claim 1. However, as evidenced by Minami et al [“Minami”] or Nishikawa et al [“Nishikawa”], such triphosphate compounds are well-known in the art as antiwear agents in lubricating oil compositions. See the phosphorus-containing compounds represented by the formula in col.1, lines 52-58, in Minami, wherein the X substituents may all be oxygen. Minami also discloses lubricating oil compositions suitable for use in internal combustion engines in column 2, lines 3-23. Nishikawa discloses alkyl phosphates in column 2, lines 9-15, which may be used as an additive to lubricants. Having the prior art references before the inventors at the time the invention was made it would have been obvious to the skilled oil formulator to have added the triphosphate compound of either Minami or Nishikawa the oil composition of Nakazato if its known imparted property was so desired. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the disclosure in Nakazato allowing for the addition of phosphorus-containing compounds to the lubricating oil compositions.

In response applicants amended independent claim 1 to include that the composition contains no zinc dialkyldithiophosphates and argued that it has been clearly demonstrated in the Examples that compositions which do not contain zinc dialkyldithiophosphates as claimed exhibit superior properties. Applicants argue that zinc dialkyldithiophosphate is an essential

Art Unit: 1797

component of the Nakazato composition and is contained in all the Examples of the prior art, and that Nakazato does not teach or suggest a composition containing no zinc dialkyldithiophosphates as claimed. This is not deemed to be persuasive because zinc dialkyldithiophosphates are extremely well known lubricating oil additives which are effective as antioxidants and as extreme pressure/anti-wear agents. Nakazato teaches the addition of conventional zinc dialkyldithiophosphates to the lubricant composition in a very minor amount of 0.01 weight % in terms of a phosphorus content. Further, it has been held that the elimination of a step or an element is obvious if the function of the element is not desired. See MPEP 2144.04. The examiner is of the position that it would have been obvious to the skilled oil formulator to have omitted the conventional zinc dialkyldithiophosphate component from the lubricating oil composition of Nakazato if the function attributed to the component was not desired or required. See *Ex Parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1797

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/

Ellen M McAvoy
Primary Examiner
Art Unit 1797

EMcAvoy
August 4, 2008

Application/Control Number: 10/822,480
Art Unit: 1797

Page 7